REMARKS/ARGUMENTS

Claims 1-26 are pending in the application. Reconsideration and reexamination of the application are hereby respectfully requested.

In the Claims:

Claim 22 stands objected to under 37 C.F.R. 1.75(c) as being in improper form due to multiple dependency. Claim 22 is amended herein to depend only from claim 21 and as needed due to amendments in independent claim 21.

Claim Rejections – 35 USC§ 112

Claims 21 and 23 stand rejected under 35 USC 112 second paragraph as indefinite omnibus type claims. Claim 21 is amended in order to better conform to US practice. Original claim 23, which depends from claim 21, is believed to be in satisfactory form, now that claim 21 is amended.

Claim Rejections – 35 USC §103

Claims 1-21 and 23-26 stand rejected under 35 USC 103(a) as 26 as unpatentible over US 5,373,905 to Bleicher in view of US 2,729,076 to Thomson. Applicant respectfully traverses the §103 rejection. First, the independent claims do not read on the proposed combination. Second, there is no suggestion or motive to make the proposed combination.

The application contains four independent claims: 1, 11, 21, and 24.

The Proposed Combination Does Not Satisfy the Claim Limitations:

Independent claims 1, 11, and 21 all require:

a first clutch member mounted to and slideable on the spindle;

a first basing means acting between the spindle and the first clutch member;

a second clutch member capable of moving relative to the first; and

a second biasing means acting between the first and second clutch members.

PAGE 10/13 * RCVD AT 2/27/2006 4:05:05 PM [Eastern Standard Time] * SVR:USPTO-EFXRF-2/0 * DNIS:2738300 * CSID:410 716 2610 * DURATION (mm-ss):04-00

Although the Examiner has not described his proposed combination of elements in any detail, it is not possible to see how any effective combination of components from Bleicher '905 and Thomson '076 would place a second biasing means "adapted to act between said first and second clutch members." Claims 1 and 11, claim 21 similar. The various biasing elements in Bleicher '905 (15) and Thomson '076 (17,18,19) are conventionally arranged to act between an axially fixed component (Bleicher '905 guide tube 7 and washer 18; Thomson '076 adaptor 7) and an axially movable clutch member (Bleicher '905 gearwheel 12; Thomson '076 driving clutch component 14). In neither case does the biasing element act between both between the first and second clutch members of the cited references.

Regarding dependent claim 24, it requires "a sliding hub slidably mounted on the spindle having at least one spline . . .which engages corresponding trough formed along the length of the spindle [and] characterized in that the trough and spline are correspondingly tapered along their length." Bleicher '905 discloses no splined structure. In so far as Thomson '076 teaches that spring block (18) and driving component (14) are splined to an intermediate length (22) of the shaft, it does not show the spline at all and the troughs are not described or depicted as "tapered along their length." *See* Thomson '076 FIGS 1 and 2, and at col. 2 lines 48-58.

Thus, Applicant respectfully submits that the proposed combination would not satisfy all the limitations of the subject application's independent claims.

The Proposed Combination Is Neither Suggested Nor Motivated By The References:
Secondly, even if the cited references could provide components that satisfy all the claim limitations, there is no suggestion or motive to make that combination. Although a prior art device "may be capable of being modified to run the way [the patent applicant's] apparatus is claimed, there must be a suggestion or motivation in the references to do so. *In re Mills*, 916 F.2d 680, 682, 16 USPQ2d 1430 (Fed. Cir. 1990). The grounds for rejection need to specifically identify the teaching and/or motivation that would lead one of ordinary skill in the art to select the references and

PAGE 11/13 * RCVD AT 2/27/2006 4:05:05 PM [Eastern Standard Time] * SVR:USPTO-EFXRF-2/0 * DNIS:2738300 * CSID:410 716 2610 * DURATION (mm-ss):04-00

combine them in the way proposed. *See In re Lee*, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002). *See also* MPEP §2143.01.

Here, the Examiner has not identified the teaching or suggestion that would motivate the proposed combination. That suggestion is not found in Bleicher '905 and Thomson '076 themselves. Both Bleicher '905 and Thomson '076 each contain an overload clutch assembly. As described and depicted in Bleicher '905 and Thomson '076, the respective clutch assemblies appear to be sufficient for their intended purposes and the Applicant can see no reason that anyone would be motivated to incorporate elements from Thompson '076 into Bleicher '905.

Furthermore, although the Examiner has not provided any detail about how the Bleicher '905 and Thomson '076 components would be combined, there seems to be a good chance that such a combination would render Bleicher '905 unsatisfactory for its intended purpose. In Bleicher '905 the gearwheel (12) is both axially slideable and rotatable relative to the guide tube (7). If the splined connection of the driving component (14) to shaft (22) were borrowed from Thomson '076, then the Bleicher gearwheel (12) would be splined to and rotationally fixed relative to the guide tube (7), which would render the Bleicher clutch non-functional. So, at least as regards subject claim 24, the proposed combination would be unsatisfactory, and if the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *See, In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984), *see also* MPEP §2143.01.

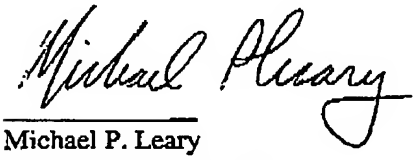
Assuming for the sake of argument that it is possible that components from the cited reference s could be combined in ways that avoid this pitfall, those combinations have not been described in the Action, and in so far as it is necessary to carefully pick and choose components from the two references and to thoughtfully combine them so as to avoid compromising the intended function, then it does not seem accurate to describe such a combination as "obvious", even to one of ordinary skill in the art.

PAGE 12/13 * RCVD AT 2/27/2006 4:05:05 PM [Eastern Standard Time] * SVR:USPTO-EFXRF-2/0 * DNIS:2738300 * CSID:410 716 2610 * DURATION (mm-ss):04-00

Having traversed the §103 rejection as to the independent claims, the Applicant believes it is not necessary to separately address the numerous dependent claims.

The Applicant wishes to thank the Examiner for the consideration shown to the Application. He believes that the amendments and remarks herein properly address the objections and rejections raised. The Applicants therefore believes that the Specification and Claims are in condition for allowance and respectfully requests that a timely Notice of Allowance be issued in this case.

Respectfully submitted



Michael P. Leary
Registration No. 41,144
Attorney for Applicant(s)
February 27, 2006

Michael Leary - TW199
The Black & Decker Corporation
701 East Joppa Road
Towson, Maryland 21286
Telephone: (410) 716-2773

PAGE 13/13 * RCVD AT 2/27/2006 4:05:05 PM [Eastern Standard Time] * SVR:USPTO-EFXRF-2/0 * DNIS:2738300 * CSID:410 716 2610 * DURATION (mm-ss):04-00